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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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on n/a Electronically Filed on October 19, 2010

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Application Number

10/092,385

Filed

March 5, 2002

First Named Inventor

Jeffery J. Sheldon

Art Unit

3773

Examiner

Darwin P. Erez

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Mark T. Garrett/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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October 19, 2010

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 3 forms are submitted.

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Arguments in Support of Pre-Appeal Brief Conference Request for 10/092,385

The Office rejects claims 1, 2, 25, and 26 as being obvious over US 6,027,529 TO Roychowdhury *et al.* in view of 5,716,365 to Goicoechea *et al.* (and as evidenced by US 6,251,135 to Stinson). These rejections lack factual and legal support and should be withdrawn.

The Office's rejection is premised on the notion that "the weld of Roychowdhury and the knot of Goicoechea are viewed as well known equivalents for securing strands together." Final Action at 4. This premise allows the Office to contend that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Roychowdhury to use knots instead of a weld since it has been held that a mere simple substitution of one known element (securing element) for another will yield predictable results." *Id.* However, that premise conflicts with Roychowdhury's teachings.

Roychowdhury makes clear that the only acceptable connection technique is one that fixes the position of the two crossed wires with respect to each other, such as resistance welding, laser welding, ultrasonic welding, induction welding, braising, soldering (3:10-15; 9:5-30), electron beam welding, arc welding, sinter bonding or solid state diffusion bonding, friction welding, and explosive bonding based on pressure shock waves (9:31-39). The bond created between the crossed strands using these permanent connection techniques provides "a radial stiffness" that is "[a] salient advantage of the invention" and "enables a winding of helical strands 32 at substantially reduced braid angles." 6:29-31. The strength of those bonds is important because Roychowdhury's welded locations are intermittent and used "at selected crossing or intersections, to provide weld patterns that enhance radial rigidity without significantly reducing axial bending flexibility," 10:21-26; *see also* 10:26-32.

Nothing in Roychowdhury suggests that these results could be met by using Goicoichea's suture material to tie the relevant crossed strands together. Nothing in Goicoechea teaches or suggests that such a tie could immobilize two crossed strands and achieve the structural results of enhanced radial rigidity without significantly reducing axial bending flexibility that is required by the intermittent weld placement scheme set forth in Roychowdhury. To the contrary, Applicant submits that substituting Roychowdhury's welds with Goicoichea's tied sutures would render Roychowdhury unsuitable for its intended purpose.

For at least these reasons, the obviousness rejection of claims 1, 2, 25 and 26 should be withdrawn.

The Office argument that column 14, lines 54-58 of Stinson is evidence "that welding and knotting are well known equivalents" (Final Action at 4) is incomplete and not relevant. While those two techniques may each be suitable for accomplishing the goal of the Stinson reference—which concerns adding radiopaque markers to crossed strands "to improve the radiopacity and the locatability of the endoprostheses in various medical procedures" (Stinson at col. 2, lines 2-10)—Stinson's goal has nothing to do with Roychowdhury's goal of fixing the position of two crossed wires with respect to each other. Accordingly, Stinson does not provide evidence that welding and knotting are well known equivalents for the purpose of securing strands together.

The Office also disagrees with Applicant's argument that "Roychowdhury makes clear that the only acceptable connection technique is one that fixes the position of the two crossed wires with respect to each other, such as resistance welding, laser welding, ultrasonic welding, induction welding, braising, soldering (3:10-15; 9:5-30), electron beam welding, arc welding, sinter bonding or solid state diffusion bonding, friction welding, and explosive bonding based on

pressure shock waves (9:31-39)” because column 3, lines 10-15 of Roychowdhury “recites a ‘preferred manner of forming the secured crossings’ and does not recite [the] ‘only acceptable connection technique.’” Final Action at 5. The Office is incorrectly characterizing Applicant’s argument and incompletely quoting Roychowdhury. Applicant argued that Roychowdhury makes clear that the only acceptable connection technique is one that **fixes** the position of the two crossed wires with respect to each other. That is consistent with and supported by the Office-cited portion of Roychowdhury, which states “[t]he preferred manner of forming the secured crossings is **by welding the adjacent strands. . . . Braising or soldering may also be used.**” (Col. 3, lines 10-15) (emphasis added). In other words, Roychowdhury is indicating that welding is preferred *to braising or soldering*, all of which are techniques for **fixing** the position of two cross strands with respect to each other. Nowhere does Roychowdhury state or suggest that welding is preferred but tying would suffice. Accordingly, the asserted modification of Roychowdhury would render Roychowdhury unsuitable for its intended purpose. As there is no suggestion or motivation to make the proposed modification because the proposed modification would render Roychowdhury unsuitable for its intended purpose, the Office has not established a *prima facie* case of obviousness. See M.P.E.P. § 2143.01(V).

The Office rejects claims 12 and 14 as being obvious over Roychowdhury in view of Goicoechea as applied to claim 1, and further in view of The Ashley Book of Knots. The combination of Roychowdhury and Goicoechea as applied to claim 1 fails for at least the reasons set forth above. The Ashley Book of Knots does not remedy that failure. Accordingly, the rejection is overcome and should be withdrawn.